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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/657,880

09/09/2003

Jon B. Telcen

JBT-1

2628

34491

7590

08/04/2006

JAMES K. POOLE, ESQ.

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EXAMINER

GEHMAN, BRYON P

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,880

Applicant(s)

TELLEEN, JON B.

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8,10,13-18,21 and 30-50 is/are pending in the application.
- 4a) Of the above claim(s) 34,35 and 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8,10,13-18,21,30-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 4, 2006 has been entered.

2. Applicant's request to consider the species of Figures 1 and 2 (Species I) and Figures 6 and 7 (Species V) I in the reply filed on April 4, 2006 is acknowledged. However, the general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. See MPEP 819. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03. Also, applicant still does not identify the species as obvious variants of one another, as required for more than one species to be considered, but apparently considers four or more panels of patentable distinction. Claim 34, as now amended, claim 35 and newly submitted claims 37-50 do not read on the elected species and are

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accordingly withdrawn from consideration. With respect to claim 10, there is not seen in Figures 1 or 2 a cord or strip as claimed.

The requirement is still deemed proper and remains FINAL.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the subject matter of claim 10 is not found in the elected species of Figures 1 and 2, the arrangement as now claimed appears to be unsupported by the disclosure with respect to any species. To any degree applicant may argue that the strip or cord as claimed applies to all species, it is not seen there is any disclosure of any arrangement of a cord or strip as now set forth in claim 10.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1, 2-5, 8, 13-17, 30-33 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 4, "said access means" is indefinite, as the access means is not positively included as an element of the claimed holder assembly, and "said" should be --the--.

In claims 31-33 and 36, line 1 of each, "holder assembly combination" lacks antecedent basis for a "combination" being defined.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3-5, 13, 17-18, 21, 30-33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright (Figures 2-8) (6,901,370). Disclosed is a holder assembly for an access means (key card 902 secured at 212) comprising a holder (212) which comprises at least one pocket, slot, envelope or pouch for holding the access means, a security device comprising a space identification portion (at 406 and 407 and above 210 in Figure 2) and further comprising one incentive (provision of perforations 210 or desire for separate use of the coupon marked "Swim for Free" included on the

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space identification portion therewith) motivating a user to separate the identification portion (above 210) from the access means (902 and below 210).

As to claim 3, the space is disclosed as being a hotel room, the remainder of possibilities being obvious variants as shown by applicant's indication of the group as functional equivalents.

As to claims 4 and 5, two panels (on either side of 202) of sheet material and printed matter are disclosed.

As to claim 13, perforations (210) are disclosed to separate the identification portion from the access means.

As to claims 17-18, 21 and 32, the holder assembly and security device will not allow use of the key or card unless removed from the holder assembly and security device.

As to claim 36, a map is clearly disclosed.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3-5, 13, 17-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin (5,529,172). Disclosed is a holder assembly for an access means (key shaped entry means 2) comprising a holder (4, 8 and/or 10) which

comprises at least one pocket, slot, envelope or pouch for holding the access means, a security device (6) comprising a space identification portion (17) and further comprising one incentive (use of a coupon included on the space identification portion 17 therewith, see col. 2, lines 59-67) motivating a user to separate the identification portion from the access means (2).

As to claim 3, Laughlin discloses the space as being a hotel room, the remainder of possibilities being obvious variants as shown by applicant's indication of the group as functional equivalents.

As to claims 4 and 5, Laughlin discloses two panels (6, 17) of sheet material, and printed matter (a coupon).

As to claim 13, Laughlin discloses perforations (16) to separate the identification portion from the access means.

As to claims 17-18 and 21, Laughlin's holder assembly and security device will not allow use of the key or card unless removed from the holder assembly and security device.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art employed against claim 1 above, and further in view of Hollar Jr. (1,667,258). Hollar Jr. discloses an envelope or pouch (1) for securing a key prior to employment. To modify Wright or Laughlin employing the envelope or pouch teaching of Hollar Jr. would have been obvious in order to secure from tampering with the key prior to its use.

12. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art employed against claim 1 above, and further in view of Thompson et al. (6,520,542). Thompson et al. discloses a peelable portion (16) (Figure 16) separable to separate and also reveal information. To modify Wright or Laughlin employing the peelable portion teaching of Thompson et al. would have been obvious in order to separate and reveal information by the separation, as suggested by Thompson et al..

13. Claims 16 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art employed against claim 1 above, and further in view of Jacobs et al. (4,488,737). Wright and Laughlin have been explained above. Jacobs et al. disclose the desirability of keeping an access means separate from a room number for security reasons (see col. 1, lines 15-26). To provide instructions to do so as part of the information indicia of Wright or Laughlin would have been obvious in view of Jacobs et al. in order to keep the access means unidentifiable if lost.

14. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin in view of Wright (6,901,370). Wright discloses a key packet including a map (308). To modify the holder assembly of Laughlin employing the map provision teaching of Wright would have been obvious in order to provide location information to the holder user.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1, 3-5, 8, 13-18, 21 and 30-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-5, 8, 13-18, 21 and 30-33 of copending Application No. 11/007619. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter as set forth in the instant claims is derivable from the claims in view of the disclosure of the application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Applicant's arguments filed April 4, 2006 have been fully considered but they are not persuasive. The amendment made to Claim 1 is not seen to add any structure different than already found in Laughlin, as explained above, and the functionality as

claimed is considered met by Laughlin as well. Reconsideration of the Wright reference, previously employed as a secondary reference alone, renders that reference as more pertinent to the instant claims than before, and appropriate rejections have been made. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Bryon P. Gehman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Bryon P. Gehman
Primary Examiner
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BPG